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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,263

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EXAMINER

RAMILLANO, LORE JANET

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

05/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/743,263	Applicant(s) SIEBEN, ULRICH	
	Examiner LORE RAMILLANO	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 7-46 is/are pending in the application.
- 4a) Of the above claim(s) 12-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-11,45 and 46 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/25/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. In applicant's reply filed on 1/25/08, applicant amended claims 1, 2, 5, 7-11, and 45-46; and cancelled claim 4. Claims 12-44 are withdrawn. Claims 1-2, 5, 7-11, and 45-46 are under examination.
2. This application contains claims 12-44 drawn to an invention nonelected with traverse in the reply filed on 9/11/06. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Amendment

Claim Rejections - 35 USC § 112

3. The rejection of claims 1-2, 5, 7-11, and 45-46, under 35 U.S.C. 112, second paragraph, is withdrawn.

Claim Objections

4. The objection to claim 7 is withdrawn. In light of applicant's amendments, a new objection follows.

Claim 1 is objected to because of the following informalities: delete "s" in the term, "chemicals". Appropriate correction is required.

Prior art rejections

5. The rejections over Zeleny, and Zeleny in view of Woods are withdrawn; and the rejections over Woods and Sheridan are maintained.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-2, 5, 7-11, 45, and 46** are rejected under 35 U.S.C. 102(e) as being anticipated by Woods (US 2003/0177380).

Woods discloses two carrier media (i.e. [0074]) of a set of carrier media for analyzing one or more analytes comprising: each of the carrier media (i.e. 112, fig. 3, array, [0074]) having a plurality of defined regions (i.e. 116a-c, fig. 5), where each of the defined regions has one of a plurality of different biological or chemical substances applied (i.e. biopolymers, e.g. in the form of polynucleotides, [0075]) and the arrangement of the plurality of defined regions on each of the carrier media is different (i.e. fig. 5, [0067], [0074]-[0075]); and each of the carrier media having a uniquely associated code (i.e. 8, fig. 1A, [0063]) that indicates which one of the substances is applied in which one of the defined regions, where the substances are disposed differently in the defined regions on two carrier media (i.e. [0074]-[0075]), where the code is from the group that comprises a bar code, a numeric code, an alphanumeric code, and an arrangement of the plurality of defined regions on the carrier medium (i.e. 8, fig. 1A, [0063]; 116a-c, fig. 5).

Woods further discloses the following: where several hundred substances are applied in a corresponding number of the defined regions (i.e. [0065]-[0068]); each of the carrier media comprises a temperature sensor (i.e. 4, fig. 1A, [0062]); where the code provides information for a device reading each of the carrier media as to how the device should read each of the defined regions (i.e. [0022]-[0025]); where the code contains information on the expiration date of each of the carrier media (i.e. [0022]-[0025]); where the code contains information on the storage of each of the carrier media from the time each of the carrier media is manufactured until the time each of the carrier media is used (i.e. [0022]-[0025]); where each of the carrier media comprises a material from the group that includes a film, a glass carrier, or a paper (i.e. [0069]-[0072]); and where the plurality of substances are from the group comprising biological substances and chemical substances, and where the group includes DNA, RNA, proteins, and antibodies (i.e. [0065]-[0068]).

8. **Claims 1-2, 5, 7-11, 45, and 46** are rejected under 35 U.S.C. 102(e) as being anticipated by Sheridan et al. ("Sheridan," US 2003/0027342).

Sheridan discloses two carrier media (i.e. 106, fig. 3) of a set of carrier media for analyzing one or more analytes, comprising: each of the carrier media having a plurality of defined regions (i.e. 504, fig. 5), where each of the defined regions has one of a plurality of different biological or chemical substances applied (i.e. [0030], [0048]) and the arrangement of the plurality of defined regions on each of the carrier media is different (i.e. [0048]); and each of the carrier media having a uniquely associated code (i.e. 412, figs. 4-6, [0061]) that indicates which one of the substances is applied in which

one of the defined regions, where the substances are disposed differently in the defined regions on the two carrier media (i.e. [0048]), where the code (i.e. 412, figs. 4-6, [0061]) is from the group that comprises a bar code, a numeric code, an alphanumeric code, and an arrangement of the plurality of defined regions on each of the carrier media.

Sheridan further discloses the following: where several hundred substances are applied in a corresponding number of the defined regions (i.e. [0030], [0048]); each of the carrier media further comprising a temperature sensor (i.e. [0031]); where the code provides information for a device reading each of the carrier media as to how the device should read each of the defined regions (i.e. [0047]); where the code contains information on the expiration date of each of the carrier media (i.e. [0047]); where the code contains information on the storage of each of the carrier media from the time each of the carrier media is manufactured until the time each of the carrier media is used (i.e. [0047]); where each of the carrier media comprises a material from the group that includes a film strip, glass carrier, or paper (i.e. microscope slides are generally made of glass, [0030]); and where the plurality of substances are from the group comprising biological substances and chemical substances, and where the group includes DNA, RNA, proteins, and antibodies (i.e. [0030]).

Response to Arguments

9. Applicant's arguments, see p., filed 1/25/08, with respect to claims 1-2, 4, 7-11, 45, and 46 by Zeleny have been fully considered and are persuasive. This rejection has been withdrawn.

10. Applicant's arguments, filed on 1/25/08, with respect to Woods and Sheridan, have been fully considered but they are not persuasive.

Rejection by Woods

In response to applicant's argument that Woods fails to disclose the feature of the amended claim 1 of "where the substances are disposed differently in the defined regions on two different carrier media," examiner disagrees. Woods expressly discloses having more than one array (carrier media) and expressly discloses that any of the arrays are different in paragraph [0074]. Furthermore, Woods discloses that the spots (defined regions) are different in paragraph [0075] and the biological and/or chemical substances on the arrays include at least two distinct polymers in paragraph [0067].

In response to applicant's argument that Woods does not specify or suggest what the differences are between the arrays, examiner disagrees. Here, claim 1 recites having different biological or chemical substances and the arrangement of the defined regions are different. Woods reads on both types of differences, as disclosed in paragraphs [0067] and [0074]-[0075].

Rejection by Sheridan

In response to applicant's argument that Sheridan fails to disclose the feature of the amended claim 1 of "where the substances are disposed differently in the defined regions on two different carrier media," examiner disagrees. Sheridan expressly discloses having more than one array (substrates, 106, fig. 3) and expressly discloses that the arrays are discrete in paragraph [0048]. Furthermore, Sheridan expressly

discloses that the samples of material (504, fig. 5, defined regions) are different in paragraph [0048].

In response to applicant's argument that Sheridan does not specify or suggest what the differences are between the arrays, examiner does not find this argument convincing. Here, claim 1 recites having different biological or chemical substances and the arrangement of the defined regions are different. Sheridan reads on both types of differences, as disclosed in paragraph [0048]. Furthermore, it would be inherent that each substrate disclosed by Sheridan is different since Sheridan explicitly discloses that each substrate comprises a plurality of discrete samples of material and the sample of material are arranged in discrete rows and columns.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORE RAMILLANO whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

Lore Ramillano
Examiner
Art Unit 1797